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REMARKS-General

The application is rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Bates, Carter, Kiernan, and Powell. Of note, the rejection of claims 14-18 is completely dependent upon Bates.

Much of the cited prior art has priority date after that of the current application, and is thus not germane to a 35 U.S.C. 103(a) rejection. In addition, even if the cited prior art had an appropriate priority date, the described combinations do not meet the limitations of the current application.

Much of the cited prior art has priority date after that of the current application.

The current application is a continuation of the application 09/015,660, filed on 1/29/98. However, 09/015,660 claimed priority to provisional application 60/036,305, filed 1/29/97. The disclosure in the provisional application 60/036,305 establishes the priority date for the claims in the current application. Thus, the current application has priority over Bates (U.S. patent #5,987,482, filed 9/8/97) and Carter (U.S. patent # 5,953,726, filed 11/24/1997).

Although the two documents from Powell represent copies of the Cornell Library News, one the May/June 1995 newsletter, and the other the February/March 1995 newsletter, there is no evidence that these documents were originally distributed in this format in 1995. Therefore, the Applicant respectfully requests that the Examiner provide documentary evidence that the current screenshots of these newsletters, apparently taken from the internet, represent the actual state of these documents at a time that has clear priority relative to the current application.

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In spite of these limitations on their relevance, the Applicant will address the

differences between the current application and all of the prior art cited by the Examiner.

The Applicant hopes that this will aid in a rapid allowance of the application, because

even if the cited art had priority to the current Application, it is not relevant to a

determination of obviousness.

Summaries of the cited prior art and of the current application

Bates (U.S. Patent #5,987,482, filed 9/8/97) describes a method for organizing

hyperlinks, such that the internal or external nature of a given hyperlink is more obvious

to a user, and that the relative location in a document to which a hyperlink refers is

visually demonstrated to the reader (via a diagram, a pop-up, or a scrollbar).

The two references from Powell are examples of documents that include tables of

contents, each table of contents comprising a list of hyperlinks, such that clicking on one

hyperlink in the table of contents causes the material (also present within the same web

page that includes the table of contents) referred to by that hyperlink to be shown at the

top of the browser window.

Carter (U.S. patent # 5,953,726, filed 11/24/1997) describes a method for

modification of the contents of a multiple inheritance concept hierarchy database. The

O.A. cites Figures 26 and 27 of Carter, which are examples of expanding and collapsing

graphical representations of categories and attributes of elements in such a database. In

addition, col. 6, lines 32-67 and col. 10, lines 34-43 are cited as examples of moving

nodes to different locations in order to modify hierarchies.

Kiernan (U.S. patent #5,701,137, filed 5/24/1995) describes methods for maintaining hierarchical tree-based data structures, and provides specific ability to separate a tree control at a node to create a new tree control. The O.A. cites Figures 2 and 4 of Kiernan, which are examples of expanding and collapsing graphical representations of nodes in such a tree, and col. 9, lines 45-54, which mentions moving nodes in a tree control by dragging and dropping a node to a different location.

The current application describes a user interface to a text that comprises an outline, such that elements of the outline refer to entire sections of the text, and such that each section of the text has a corresponding outline element. When the user requests an operation to be performed on the outline, this causes the operation to be performed on the section of text that corresponds to the particular outline element. In addition, results of operations on entire sections of text are displayed on the outline, in the appropriate location.

Even if the cited art had priority over the current application, the described combinations do not meet the limitations of the claims in the current application.

The O.A. cites Bates and Powell as examples of performing, in response to a signal from a user of the computer system, an operation on the entire portion of the text represented by at least one element of the outline. This same argument is relied upon by the Examiner in rejecting dependent claims 2 and 3. The following passages are excerpted from the Office Action:

Bates "figure 6, #126: the fact that a user can click on Here #126 to return to Table of Contents indicates that an operation is carried out, in response to a signal from a user, on the entire portion of text from the bottom of the document to go back to the Table of Contents on the top."

Powell: "pages 1-6: it was well known in the art that when a user can click on an element of the table of content, which is correspondent to a signal from a user, to select a desired portion of the text, the system will effect on the entire text by moving the current cursor to the selected portion of the text and display said portion on the current display."

The Applicant respectfully points out that following a hyperlink, as each of these references are examples of, is not tantamount to performing an operation on an entire portion of text represented by at least one element of the outline. Following of hyperlinks typically causes the location referred to by the hyperlink to be looked up in a table (that is generated when the document first loads into the browser), and then causes the top of the browser window to be set to the text location referred to by that hyperlink (in this case, within the current document). This does not involve any processing of the entire portion of text represented by the outline element, as would be required for this action to meet the claim of the application ("performing an operation on the entire portion of text represented by at least one element of the outline" requires the entire portion of text to be used as input for the operation).

With respect to claim 5, it is not obvious that the table of contents in Powell or Bates were computer generated, as claimed by the O.A. In fact, it appears likely that the hyperlinks within these tables of contents were manually inserted by the individual who originally converted these documents to hypertext.

With respect to claim 7, the O.A. shows means by which at some time, the outline display may correspond to the text being shown, but this is not the same as showing that

at any given time (which means at all times) the portion of the outline displayed corresponds to the text being displayed. Thus, the O.A.'s examples to claim 7 do not meet the limitations of the claim.

With respect to claim 8, the O.A. cites a hyperlink associated with the display of an outline element as an example of "a result displayed on the outline." However, results of operations on the text (as specified in claim 1) are different from elements of the outline (like "Class Offering" or "Introduction"). The examples in Powell and Bates cited by the Examiner are not results of operations, and thus, do not meet the limitations of the claim.

With respect to claim 9 and 10, the O.A. misinterprets the definition of "reverse-indexing" (an example of which is provided on page 74, line 24 to page 75, line 21 of the specification). Reverse indexing refers to identification of portions of text that are cited by the same or related index entries, and is not, as stated in the Office Action, the inclusion of an index in reverse alphabetical order. Thus, the explanation for rejection of claims 9 and 10 is not relevant.

With respect to claim 11, the following of a hyperlink is not the same as searching within a portion of text referred to by an outline element. Thus the cited passages (Bates, col 6, lines 49-57, and Powell, screen shots, pages 1-2) do not meet the limitations of this claim.

With respect to claims 12 and 13, which are dependent on claim 2, the O.A. suggests that a user could manually select text referred to by an outline element, and then print or copy the selected text. However, claim 2 requires that the user be provided the ability to select an element in the outline, such that the operation (printing in claim 12

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and copying in claim 13) is performed on the entire portion of text referred to by the

element. The description in the O.A. does not meet the limitation of selecting an element

in the outline. Thus, this example does not meet the limitations of claims 12 and 13.

With respect to claim 17, the O.A. cites the pop-up window of Bates, Figure 12

and Bates, col. 9, lines 63-67 describing that pop-up window as evidence that annotations

to the text are displayed on the outline. However, the pop-up window of Bates contains

information about the location of Chapter 1, relative to the current position of the

document. Information about the relative location of Chapter 1 cannot be construed as

annotations to portions of text within Chapter 1, both because such information does not

meet the definition of "annotation" as described in the specification, and because this

information refers only to the location of the beginning of Chapter 1, rather than being

relevant to the actual text within Chapter 1.

With respect to claim 18, the time spent for viewing text may well not be

proportional to the length of the text, as when a particular passage requires additional

attention by the reader. Thus, calculation of a parameter related to the length of a text

section is not the same as calculating the amount of time that a given reader spends

reading that text. In fact, the amount of time spent viewing the text would likely vary

from reader to reader, but the length of a text section would always be the same. Thus,

the example of the O.A. does not meet the limitations of claim 18.

With respect to independent claims 21 and 22, the cited prior art is not relevant to

these claims for the same reason as for claim 1.

Combination of Bates or Powell with Kiernan or Carter does not arrive at the present invention, and appropriate motivation for these combinations is not provided.

With respect to claim 19, neither Kiernan nor Carter discloses moving text within a text document in response to moving outline elements from one location to another. In other words, the result of moving outline elements from one location to another (as in the current application, where moving outline elements also causes the corresponding text to be moved within a linear text document) is not disclosed by either Kiernan or Carter (or any combination with Bates or Powell). Thus, combination of Bates or Powell with Kiernan or Carter does not arrive at the present invention.

Kiernan and Carter disclose means of keeping track of hierarchical relationships as tree structures are modified. In order to combine these references with other references (such as Bates or Powell) to arrive at the current invention, it would be necessary to provide a motivation for doing so. While the O.A. cites similarities between tree data structures and tables of contents as motivation for combining these inventions, no motivation is provided for doing this in the context of the outline of a text document, where (as in claim 19) moving outline elements also causes the corresponding text to be moved within a linear text document. In other words, in order to combine these references, it would be necessary to demonstrate a motivation to convert the table of contents of a text document into a tree data structure. E.g., as was stated in In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983):

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"[P]rior art references in combination do not make an invention obvious unless
something in the prior art references would suggest the advantage to be derived
from combining their teachings."

Conclusion

For all of the above reasons, the specification and claims are in proper form, and

the claims all define patentably over the prior art. Therefore, this application is in

condition for allowance, which action is respectfully solicited.
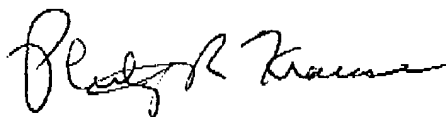
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Request for interview and constructive assistance

Based on the arguments herein, the specification and claims of this application are

proper, definite, enabled, and define novel subject matter which is also non-obvious.

Applicant respectfully requests an interview at which the invention may be demonstrated,

the relevance of the prior art and the issues in this response may be discussed, and the

constructive assistance and suggestions of the Examiner pursuant to MPEP 2173.02 and

707.07 (j) may be received.

Very Respectfully,

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Attachment: USPTO form PTO/SB/17
               USPTO form 2038

Certificate of Facsimile Transmission

I certify that on the date below, I will fax this communication and attachments, if any, to
Group 2178 of the Patent and Trademark Office at the following number: 703-872-9306.

Date:___6/7/04____
Inventor's Signature_____